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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,857	12/01/2003	Sharon Lesk	7288-102/10312532	2832
167 7590 02/03/2010 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071				
EXAMINER GEHMAN, BRYON P				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
02/03/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/725,857

Applicant(s)

LESK ET AL.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 7-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3,5 and 7-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 and 13 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. In view of the appeal brief filed on November 4, 2009, PROSECUTION IS HEREBY REOPENED. See the added and amended grounds of rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed groove ring extending partially around the receptacle of claims 19 and 25, and the claimed grooved ring being discontinuous, having two or more channel elements of claims 20 and 26 must be shown or the features canceled from the claims. **No new matter should be entered.**

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 19-20 and 25-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. While mentioned in the specification that the groove extends partially around the ring and the groove may be discontinuous, there is no real disclosure that the grooved ring extends partially around the receptacle or may be discontinuous as claimed. Since there is no provision in the original Figures to demonstrate what applicants' mean by this recitation, it would appear such is insufficiently disclosed to be properly claimed, and in view of applicants' improper claims, applicants are unaware what they are claiming or disclosing.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed by "the grooved ring having an outer wall and an inner wall (seen in the drawings), the outer wall being adjacent to the sidewall of the receptacle at a first distance above the closed bottom, the inner wall being at a second distance above the closed bottom, the second distance being less than the first distance" must be shown or the feature canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction, **but only if possible without introduction of new matter**, of the following is required:

There is no apparent disclosure, nor is it clear what is meant by "the grooved ring having an outer wall and an inner wall (that much clearly seen in the drawings), the outer wall being adjacent to the sidewall of the receptacle at a first distance above the closed bottom, the inner wall being at a second distance above the closed bottom, the second distance being less than the first distance". Such has never been defined in the specification, nor is such a relationship ever demonstrated in the drawings. Furthermore, should applicant be relying on the appearance of Figure 6, such is considered insufficient to provide the criticality of disclosure that applicants' now place thereon. While it may be considered the inner wall may appear lower in Figure 6, it is not definite from the original disclosure, as such was never clearly defined, and its

reliance as the crux of applicants' invention at the time the invention was submitted is in doubt.

7. Claims 1-3, 5 and 7-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The original disclosure fails to provide support for the claim limitations of "the (detachable) grooved ring having an outer wall and an inner wall, the outer wall being adjacent to the sidewall of the receptacle at a first distance above the closed bottom, the inner wall being at a second distance above the closed bottom, the second distance being less than the first distance", as set forth in claim 1, lines 9-12, claim 8, lines 8-12, and claim 10, lines 6-9, and "the ring having a groove between an outer wall and an inner wall to hold liquid, the outer wall being adjacent to the sidewall of the receptacle at a first distance above the closed bottom, the inner wall being at a second distance above the closed bottom, the second distance being less than the first distance" in claim 28, lines 7-11.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 10, lines 1-2, "in either order" is indefinite, as "either" indicates a choice between two options, while three steps would provide more than only two possible variations of the three steps' order.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 5, 7-9, 12-15, 18 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs (627,231) in view of Sakamoto (3,477,175). Hinrichs discloses a container or receptacle (A) adapted to be received in a motor vehicle drink holder (It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138), the container or receptacle comprising a closed bottom (outer bottom surface of Hinrichs), a top with an opening and a sidewall that connects the bottom and the top, and a grooved ring (defined by B1 and B2) press fitted into the opening of the top, the grooved ring having an outer wall (B2) and an inner wall (B1), with the outer wall at a first distance above the closed bottom (bottom of B2 to the bottom of the flower pot directly vertically

therebelow) and the inner wall at a second distance above the closed bottom (bottom of B1 to the bottom of the flower pot directly vertically therebelow), the second distance being less than the first distance. Hinrichs does not disclose a support means. However, Sakamoto discloses a plant stem support means (14) comprising a set of prongs (24) disposed in a plant stem receptacle. To modify the container of Ho employing the prongs of Sakamoto would have been obvious in order to support plant stems, as suggested by Sakamoto. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S. Ct. 1731, 82 USPQ2d at 1396. The variable whether the container or receptacle of Hinrichs being adapted to being received in a motor vehicle drink holder pertains to their size, and to any degree the container or receptacle of Hinrichs is not inherently sized corresponding to being received in a drink holder, to size either a container, receptacle or a drink holder sufficient to have the one fit in the other would have been obvious, as plant containers of a size to be capable of being received in a conventional drink holder have been long known in the art. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claims 5 and 8, Hinrichs discloses the ring as detachable and having a groove.

As to claim 7, the container of Hinrichs is inherently configured to stand on its own.

As to claim 8, the receptacle of Hinrichs is cup-shaped, as are all flower pots.

As to claims 12-15 and 22-23, Sakamoto disclose the supporting means (15) being removably connected at the bottom of its receptacle. However, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

As to claims 18 and 24, Hinrichs discloses a complete circumference ring.

12. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Sakamoto. The mechanical combination has been explained above. To locate any article sized to fit within a motor vehicle drink holder falls within the level of common sense, and the location of any article therein would not in itself be inventive. **Since this is traversed, applicants do not consider the method to be obvious.**

As to claim 11, to subsequently remove the plant container from the drink holder to display the plant container externally of the motor vehicle would have also been an obvious manipulation to one of ordinary skill in the field of using plant containers. **Since this is traversed, applicants do not consider the method to be obvious.**

13. Claims 1, 3 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Stone (2,057,856). Hinrichs discloses a container or receptacle (A) adapted to be received in a motor vehicle drink holder, the container or

receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a grooved ring (defined by B1 and B2) press fitted into the opening of the top, the grooved ring having an outer wall (B2) and an inner wall (B1), with the outer wall at a first distance above the closed bottom (bottom of B2 to the bottom of the flower pot directly vertically therebelow) and the inner wall at a second distance above the closed bottom (bottom of B1 to the bottom of the flower pot directly vertically therebelow), the second distance being less than the first distance. Hinrichs does not disclose a support means. However, Stone discloses a plant stem support means comprising a frog (10) that is permanently connected to its container. To modify the plant container of Hinrichs employing the frog of Stone would have been obvious in order to support plant stems therein, as suggested by Stone.

As to claims 12, 14 and 16, Stone discloses the supporting means (10) being permanently connected to the bottom of the receptacle. To provide the supporting means as a permanent connection would have been obvious to maintain the supporting means with the receptacle. However, with respect to claims 13, 15 and 17, applicants claim the relatively permanent and impermanent connections as being interchangeable. To provide an element as permanent or impermanent are the two options, and to render the element either would have been obvious to one of ordinary skill to obtain the desired permanence or removability.

14. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs in view of Stone. The mechanical combination has been explained above.

To locate any article sized to fit within a motor vehicle drink holder falls within the level of common sense, and the location of any article therein would not in itself be inventive.

Since this is traversed, applicants do not consider the method to be obvious.

As to claim 11, to subsequently remove the plant container from the drink holder to display the plant container externally of the motor vehicle would have been an obvious manipulation to one of ordinary skill in the field of using plant containers. **Since this is traversed, applicants do not consider the method to be obvious.**

15. Claims 19-20 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 1 and 9 above and further in view of Matthews (6,516,563). Matthews discloses a detachable grooved ring (24) disposed about the top of a plant and having a groove (30 and/or 32) that is discontinuous or extends partially around the ring. To modify the plant container of the previous combination employing the ring with a groove as taught by Matthews would have been obvious in order to provide an adjustable container for nutrients for the plant, as suggested by Matthews.

16. Claims 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as employed against claims 1 and 9 above and further in view of Holtkamp Jr. (5,477,640). Holtkamp discloses a detachable grooved ring (12 or between 14 and 22) disposed about the top of a plant and having a groove (containing air freshener 32 or containing 12 and 32) extending completely around the ring. To modify the plant

container of the previous combination employing the ring with a groove as taught by Holtkamp Jr. would have been obvious in order to provide an air freshener capability to the plant container, as suggested by Holtkamp Jr..

17. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hinrichs. Hinrichs discloses a container comprising a receptacle (A), the receptacle comprising a closed bottom, a top with an opening and a sidewall that connects the bottom and the top, and a ring (defined by B1 and B2) sized to be press fit into the opening of the top, the ring having a groove between an outer wall (B2) and an inner wall (B1) capable to hold liquid, the outer wall adjacent the side wall of the receptacle, with the outer wall at a first distance above the closed bottom (bottom of B2 to the bottom of the flower pot directly vertically therebelow) and the inner wall at a second distance above the closed bottom (bottom of B1 to the bottom of the flower pot directly vertically therebelow), the second distance being less than the first distance. To render the receptacle "adapted to be received in a motor vehicle drink holder" would pertain to the sizing of the bottom portion (14). It has been long held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. See *In re Hutchison*, 69 USPQ 139. "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has a good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and

common sense. In that instance, the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103. *KSR Int 'l v. Teleflex Inc.*, 127 S. Ct. 1731, 82 USPQ2d at 1396. It would have been an obvious matter of design choice to provide the prior art container of a particular desired size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. See *In re Rose*, 105 USPQ 237 (CCPA 1955).

18. Applicant's arguments with respect to the claims as presented in the Appeal Brief have been considered but are moot in view of the new and modified grounds of rejection. It was determined that most of applicants' arguments were directed to subject matter which there is a great deal of doubt whether such was ever even originally disclosed. The obtuse language about the inner and outer walls of the ring was never so described in the specification nor shown in the drawings, nor is it apparent that it was ever really disclosed except accidentally, the importance and criticality thereto by the applicants appears to be not commensurate with any disclosure on their part. Accordingly the new grounds of rejection are made. In view of the applicants' disagreement about the obviousness of the method of use, which is of different scope than the claimed structure, the following restriction requirement is now made. The examiner does not see locating a flower pot of appropriate size in a cup holder to be inventive, anymore than the examiner is an inventor when he locates his phone, pen, change, etc. in a motor vehicle cup holder.

19. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-3, 5, 7-9 and 12-28, drawn to a container, classified in class 206, subclass 423.
 - II. Claims 10 and 11, drawn to a method of using a container, classified in class 47, subclass 84.

The inventions are independent or distinct, each from the other because:

20. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of use such as a floral receptacle disposed in a house or porch, and is not structurally limited to being used in a motor vehicle drink holder.

21. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after

the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Bryon P. Gehman/
Primary Examiner, Art Unit 3728

/Mickey Yu/
Supervisory Patent Examiner, Art
Unit 3728

BPG